

REMARKS

Claims 1-3, 5-17, 19, and 21-40 were presented for examination in the present application. The instant amendment adds new claim 68. Thus, claims 1-3, 5-17, 19, 21-40, and 68 remain pending for consideration upon entry of the instant amendment. Claims 1, 15, 32, and 37 are independent.

Claims 15, 32, and 37 have been allowed.

The Office Action indicates claims 34 and 38-40 are objected to, but would be allowable if amended to include the elements of a base claim. However, Applicants submit that claim 34 depends from allowed claim 32 and claims 38-40 depend from allowed claim 37. Therefore, claims 34 and 38-40 are also believed to be allowed. Reconsideration and withdrawal of the objection to claims 34 and 38-40 are respectfully requested.

Applicants acknowledge with appreciation the indication of allowable subject matter in claims 9, 13, 17, 27, 29-30, and 36.

Independent claim 1 has been amended to remove the elements of previous claim 18, which have been re-written as new claim 68. Amended claim 1 is not intended to be limited to the specific mechanisms of patentability previously presented and the Applicant therefore rescinds any disclaimer of claim scope so any prior art, for which such a disclaimer was made to avoid, may need to be revisited by the Examiner with respect to claim 1.

Independent claim 1, as well as dependent claims 2-3, 6-7, 12, 14, 16, 19-20, 22-23, 25-26, 28, 31, 33, and 35, were rejected under 35 U.S.C. §102(b) over U.S. Patent No. 4,506,435 to Pliskin et al. (Pliskin). Dependent claims 5, 8, 10-11, and 21 were rejected under 35 U.S.C. §102(b) over Pliskin in view of the Official Notice.

Additionally, independent claim 1, as well as dependent claims 2-3 and 24, were rejected under 35 U.S.C. §102(b) over the IBM Article.

Independent claim 1 has been amended to obviate these rejections. Specifically, independent claim 1 now recites, in part, “the at least one second layer having a second thickness that is less than the first thickness so that the second layer is discontinuous and access to the at least one negatively patterned first coating is retained (emphasis added)”.

Support for these amendments can be found in the specification at least at page 25, line 29 through page 26, line 14. No new matter is added.

Applicants submit that present claim 1 is not disclosed or suggested by Pliskin or the IBM article alone or in combination with the Official Notice.

Pliskin does not employ lift-off with a discontinuous second layer as claimed, but rather discloses to deposit a continuous glass layer and selectively remove glass by etching. See Abstract of Pliskin.

The IBM-paper on the other hand discloses a lift-off-method. However, this paper fails to disclose that a discontinuous glass layer is deposited by selecting the glass-layer thickness to be lower than the photoresist layer thickness.

In accordance with 37 C.F.R. § 1.104 (d)(2) and to preserve Applicants’ argument on appeal, Applicants request that the Examiner provide an affidavit or reference that supports the rejection of the claims based on the official notice. See *In re Lee*, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002) (finding that reliance on “common knowledge and common sense” did not fulfill the PTO’s obligation to cite references to support its conclusions as PTO must document its

reasonings on the record to allow accountability and effective appellate review).

Should the next Office Action fail to supply such an affidavit or reference, Applicants request withdrawal of the rejection based on the Officially Noticed information.

Moreover, and presuming arguendo the Official Notice is supported by evidence, Applicants submit that the Official Notice fails to cure the aforementioned and other deficiencies of Pliskin and the IBM Article.

Accordingly, claim 1, as well as dependent claims 2-3, 5-8, 10-12, 14, 16, 19, 21-26, 28, 31, 33, 35 and 68, are in condition for allowance. Reconsideration and withdrawal of the rejections to claims 1-3, 5-8, 10-12, 14, 16, 19, 21-26, 28, 31, 33, and 35 are respectfully requested.

In view of the above, it is respectfully submitted that the present application is in condition for issuance. Such action is solicited. If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below.

Respectfully submitted,

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